

Appl. No. 09/768,712
Amdt. Dated June 25, 2004
Reply to Office Action of April 5, 2004

Attorney Docket No. 81922.0005
Customer No. 26021

REMARKS/ARGUMENTS:

Claims 1-6 are pending in the application. Reexamination and reconsideration of the application, in view of the following remarks, are respectfully requested.

Applicant believes the following remarks comply with requirements of form and thus may be admitted under 37 C.F.R. § 1.116(a). Alternatively, if these remarks are deemed to touch the merits, admission is requested under 37 C.F.R. § 1.116(b). In this connection, these remarks were not earlier presented because they are in response to the matters pointed out for the first time in the Final Office Action.

Lastly, admission is requested under 37 C.F.R. § 1.116(a) as presenting rejected claims in better form for consideration on appeal.

Art-based Rejections

The Official Action rejects claims 1-6 under 35 U.S.C. § 102(e) as being anticipated by Kim (USPN 6,466,292).

Applicants respectfully traverse these rejections for at least the following reasons. The Kim reference was filed in the U.S. on June 19, 2000. The present application claims priority from Japanese Patent Application Nos. 2000-019183 and 2000-019184 filed January 27, 2000, and 2000-020702 filed January 28, 2000.

Certified copies of the priority documents and certified English translations of the priority documents were previously submitted to the Office. Applicants respectfully submit that the priority documents satisfy the enablement and description requirements of 35 U.S.C. § 112, first paragraph. As such, Applicants have perfected their claim of priority under 35 U.S.C. § 119 (a)-(d). Applicants' foreign priority filing date antedates the Kim reference, and therefore Applicants request that the rejection based on the Kim reference be withdrawn.

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The above remarks were submitted to the Office in the Applicant's previous response (filed December 18, 2003) to the Office Action, dated July 31, 2003. In response to these above remarks, the Office states that the Applicant's remarks are not valid since the Kim reference claims a foreign priority date of June 17, 1999.

The Applicant respectfully disagrees with the Office's rebuttal. The pertinent date that the Applicant needs to overcome under 35 U.S.C. § 102(e) is not Kim's foreign filing date, but rather Kim's U.S. filing date which is June 19, 2000.

§ 102(e)(2) states,

"A person shall be entitled to a patent unless a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

Moreover, MPEP 2136.03 states, "35 U.S.C. 102(e) is explicitly limited to certain references 'filed in the United States before the invention thereof by the applicant' (emphasis added)." MPEP 2136.03 further states, "Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes." Thus, it is not proper to use Kim's foreign filing date in a 102(e) rejection.

Furthermore, MPEP 2136.03 goes on to state, "In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date." Thus, according to § 119(a), the Applicant's Japanese priority dates of

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January 27, 2000 and January 28, 2000 can be used to overcome Kim's June 19, 2000 U.S. filing date. Withdrawal of this rejection is thus respectfully requested.

Additional support for the Applicant's position can be found in the Hilmer doctrine.

"*In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (*Hilmer I*) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.)" MPEP 2136.03, Section I

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, in view of the foregoing remarks, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6810 to discuss the steps necessary for placing the application in condition for allowance.

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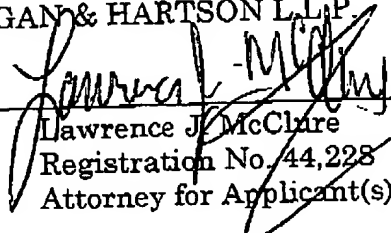
If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,

HOGAN & HARTSON LLP

Date: June 25, 2004

By:


Lawrence J. McClure
Registration No. 44,228
Attorney for Applicant(s)

500 South Grand Avenue, Suite 1900
Los Angeles, California 90071
Phone: 213-337-6700
Fax: 213-337-6701